

### **REMARKS/ARGUMENTS**

The Examiner is sincerely thanked for the courtesy of a prior telephone conversation regarding the status of the case and, further, in helping Applicant to gather the requisite information sufficient to resume prosecution of the present application. Particularly, in a telephone interview on March 3, 2004, Applicant confirmed with the Examiner that a prior Reply to the July 8, 2003 Office Action had not been filed. Applicant further appreciates the help given to the inventor in previously prosecuting the application *pro se*.

This Amendment and Response is in reply to the previous Office Action mailed July 8, 2003. In the Office Action, the Examiner objected to the drawings and rejected claims 1-14 under 35 U.S.C. § 102. Applicant has amended independent claims 1 and 9 to clarify the embodiments of the invention.

Reconsideration in light of the amendments and remarks made herein is respectfully requested.

### **Objections to the Drawings**

Applicant submits herewith formal drawings prepared by a patent draftsman to comply with the Examiner's request for corrected drawings.

### **Request for Further Information and Rejection Under 35 U.S.C. § 102(b)**

In the prior Office Action of July 8, 2003, the Examiner requested further information with regards to statements made by the inventor (Mr. Frank Jakubaitis) in his *pro se* Response to the Examiner of February 2, 2003, in which the inventor made a statement regarding a press release. Based on this statement regarding a press release, a 35 U.S.C. §102(b) rejection was issued in the prior Office Action.

As the inventor subsequently discussed with the Examiner, the inventor was actually making reference to an e-mail that was sent by the inventor to a copyrighter regarding a press release about the inventor's product. However, that press release was never published.

The inventor cannot locate a copy of this email that was e-mailed to the copyrighter.

In any event, because there was never any publication, there can, by definition, not be any public use or sale of the invention under 35 U.S.C. § 102(b). Applicant respectfully requests that the Examiner remove this 35 U.S.C. § 102(b) ground of rejection.

**Rejection Under 35 U.S.C. § 102 (e)**

Claims 1-14 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,467,684 issued to Fite et al. (hereinafter Fite). Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-14 under 35 U.S.C. § 102(e) as being anticipated by Fite, for the below reasons.

Anticipation requires that each and every element as set forth in the claim be found, either expressly or inherently described, in a single prior art reference. MPEP § 2131; Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). However, it is not enough that the prior art reference disclose all the elements in isolation. Rather as stated by the Federal Circuit, "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim*. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1985) (*emphasis added*). Thus, even if the prior art reference includes all the elements that are claimed, if the arrangement of the claimed elements is different from the arrangement of the prior art elements, anticipation will not be present. Moreover, as the Federal Circuit has stated, "[t]he *identical invention* must be shown in as complete detail as is contained in the...claim." MPEP § 2131; Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236. (*emphasis added*).

Applicant's claimed invention as set forth in amended independent claims 1 and 9 generally relates to: A system and method for distributing *digital works* among a retail merchant, a remote server, and a customer at a customer node...including...*storing the digital works* and their associated identification data on a memory of the remote server...purchasing from the retail merchant *a package associated with a desired one of the digital works*, wherein *the package includes the desired digital work's identification data and a description of the digital work*...sending a request to *access the desired digital work* from the customer node through the public communications network to the remote server...the request *specifying the desired digital work's identification data included in the purchased package*...receiving at the remote server the request to access the desired digital work...*searching the digital works* stored on the remote

server for the desired digital work specified by the identification data in the received request...*transmitting the desired digital work from the remote server through the public communications network to the customer node...receiving at the customer node the desired digital work...and storing the desired digital work on a memory of the customer node.*

In contrast, the Fite patent teaches a pre-paid card system for purchasing products or services, comprising a plurality of cards, each card having a unique identity number associated therewith and wherein the cards have different purchasing values. (Fite patent, column 1, lines 29-33, emphasis added).

Particularly, the Fite patent discloses cards 20 that are typically made of plastic and each card is issued for specific amount, which is displayed on the face. (Fite patent, column 2, lines 66-67 to column 3, line 1, emphasis added). For example, the following denominations may appear on a card are given as an example in Figure 3 (e.g. \$10.00, \$20.00, \$50.00) (Fite patent, column 3, lines 1-2, emphasis added).

A plurality of vendor terminals 14 are provided at various outlet locations conveniently situated for customers or users of the system to purchase the cards 20... At the time of purchase, the customer will select one or more of the cards 20 with the desired denominations... The cards are inactive prior to sale and are activated when read by a card reader... At this time the terminal 14 conveys information to the host database 12 that a particular card 20 is now active... Effectively, the card 20 is now comparable to a bank note in the hands of a customer. (Fite patent, column 3, lines 19-28, emphasis added).

The merchant station 16 will typically include an Internet web site advertising goods or services for sale... in order to participate in the system 10, the merchant will be registered in the host database 12 and will also be provided with an identification number or other identification means... The merchant is also provided with an account in the host database, as well as at a host bank 30, participating in the system 10... Thus, the merchant is able to produce a reference number to identify the goods or services which a particular customer is purchasing, as well as the identification number of the cash card(s) 20. (Fite patent, column 3, lines 53-65, emphasis added).

A customer will typically have his/her own computer system...connected to the Internet... and will browse the merchant websites and select goods and services at the merchant web-sites. (Fite patent, column 4, lines 39-43, emphasis added). If goods are purchased...the

merchant instantly notifies the customer upon the completion of the transaction via E-mail of the expected delivery date...If services are purchased, a services type reference number is generated which requires the merchant to notify the customer upon completion. (Fite patent, column 5, lines 9-18, emphasis added)

Accordingly, the Fite patent teaches a cash card system for purchasing physical products and/or actual services utilizing a cash card having a specific cash-value denomination (e.g. \$10.00, \$20.00) from a web-site operated by a business that subscribes to the cash card system.

Fite does not teach or suggest purchasing from a retail merchant ***a package associated with a desired digital work***, wherein *the package includes the desired digital work's identification data and a description of the digital work*...the purchaser sending a request to *access the desired digital work* from the customer node through the public communications network to a remote server...the request *specifying the desired digital work's identification data included in the purchased package*... *searching the digital works stored on the remote server* for the desired digital work specified by the identification data in the received request...and *transmitting the desired digital work from the remote server through the public communications network to the customer node*...***receiving at the customer node the desired digital work***...*storing the desired digital work on a memory of the customer node*.

In fact, Fite does not teach or suggest anything remotely close to a retail merchant selling *a package associated with a digital work, wherein the package includes the desired digital work's identification data and a description of the digital work*, and that the purchaser can then through their own customer node (e.g. personal computer) *access, receive, and store the digital work that was described by the package*.

Because Fite does not teach or suggest each and every element of amended independent claims 1 and 9, as arranged in the claims, nor does it teach *the same identical invention*, Applicant respectfully submits that anticipation is not present. Therefore, Applicant respectfully requests that this ground for rejection be removed, and respectfully submits that independent claims 1 and 9 should be allowable. Further, the dependent claims should be allowable for being dependent from allowable base claims. Moreover, Applicant respectfully submits that Fite in combination with the other references of record does not teach or suggest the elements of the amended independent claims 1 and 9, and that therefore the claims are likewise non-obvious over the art of record.

***Conclusion***

In view of the remarks made above, it is respectfully submitted that pending claims 1-14 define the subject invention over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 4/15/2004

By

  
Eric T. King

Reg. No. 44,188

Tel.: (714) 557-3800 (Pacific Coast)

Attachments

12400 Wilshire Boulevard, Seventh Floor  
Los Angeles, California 90025

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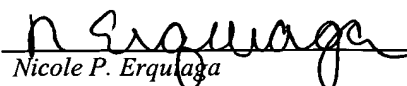
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